

REMARKS

Claims 1-6 and 10-12 are currently pending in the present application and have been rejected by the Examiner. Applicants note that all amendments of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),¹ and without waiving the right to prosecute the amended Claims (or similar Claims) in the future. In the present Office Action, the Examiner made several rejections. For clarity, the rejections are listed below in the order that they are addressed herein.

- (1) Claims 1, 3, 4-6 and 10 are rejected under 35 U.S.C. 112, first paragraph as allegedly lacking written description;
- (2) Claims 1-6 and 10-12 are rejected under 35 U.S.C. 112, first paragraph as allegedly lacking enablement;
- (3) Claims 1, 3-6, and 10 are rejected under 35 U.S.C. 102 (b) as allegedly being anticipated by any one of Pan et al. (1998) FEBS lett. 435:65 (hereinafter Pan '98); Chen et al. (1994) FEBS Lett. 147:279 (hereinafter Chen); Pan et al. (1995) Mol. Pharmacol. 47:1180 (hereinafter Pan '95); Bunzow et al. (1994) FEBS Lett. 347:284 (hereinafter Bunzow); Wick et al. (1994) Brain Res. Mol. Brain Res. 27:37 (hereinafter Wick); Grandy et al. (U.S. Patent 5,821,067, hereinafter Grandy); or Eppler et al. (U.S. Patent 5,866,324, hereinafter Eppler);
- (4) Claims 1, 3-4 and 10 are rejected under 35 U.S.C. 102 (b) as allegedly being anticipated by NCBI Database accession number UO5239.1 (1994); and
- (5) Claims 1, 3-6 and 10 are rejected under 35 U.S.C. 102 (e) as allegedly being anticipated by Yu (U.S. Patent 6,103,492; hereinafter Yu).

¹ 65 Fed. Reg. 54603 (Sept. 8, 2000).

I. The Claims are Supported by a Proper Written Description

The Examiner has rejected Claims 1, 3, 4-6 and 10 under 35 U.S.C. 112, first paragraph as allegedly lacking written description (Office Action, pg. 2). The Applicants respectfully disagree. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended Claim 1 and cancelled Claims 2-4 and 10. The amended claims are directed towards Orphanin FQ nucleic acids of SEQ ID NOs: 9, 10, 12, 14, 16, 18, 19, 20, and 21. As the Examiner has admitted that "the described nucleic acids set forth as SEQ ID NO: 9, 10, 12, 14, 16, 18, 19, 20, and 21 pr [sic] encoding SEQ ID NO: 11, 13, 15, 17 and 23 meet the written description provision of 35 U.S.C. §112." (Office Action, pg. 5), the applicants respectfully request that the Claims be passed to allowance.

II. The Claims are Enabled

The Examiner has rejected Claims 1, 3, 4-6 and 10 under 35 U.S.C. 112, first paragraph as allegedly lacking enablement (Office Action, pg. 6). The Applicants respectfully disagree. As described above, the Applicants have amended Claim 1 and cancelled Claims 2-4 and 10. The amended claims are directed towards Orphanin FQ nucleic acid of SEQ ID NOs: 9, 10, 12, 14, 16, 18, 19, 20, and 21. As the Examiner has admitted "the specification, while being enabling for a nucleic acid set forth as SEQ ID NO: 9, 10, 12, 14, 16, 18, 19, 20, or 21..." (Office Action, pg. 6), the Applicants respectfully request that the claims be passed to allowance.

The Examiner has further rejected Claims 1-4, 6, and 10-12 under 35 U.S.C. 112, first paragraph as allegedly lacking enablement (Office Action, pg. 9). In particular, the Examiner states "the specification, while being enabling for an isolated nucleic acid, and an isolated cell comprising the *vector* of claim 5...does not reasonably provide enablement for any composition comprising the isolated nucleic acid, or a cell comprising the vector of claim 5 wherein the cell is *in vivo*." (Office Action, pg. 9). The Applicants respectfully disagree. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended Claims 1 and 6. Amended Claim 1 is directed towards an isolated nucleic acid and amended Claim 6 is directed towards a cell that is *in vitro* (*e.g.*, *ex vivo*). As the Examiner has admitted that these embodiments are enabled, the applicants respectfully request that the rejection be withdrawn.

III. The Claims are Novel

The Examiner has rejected Claims 1, 3-6, and 10 under 35 U.S.C. 102 (b) as allegedly being anticipated by any one of Pan '98, Chen, Pan '95, Bunzow, Wick, Grandy or Eppler (Office Action, pg. 12). The Examiner has further rejected Claims 1, 3-4 and 10 under 35 U.S.C. 102 (b) as allegedly being anticipated by NCBI Database accession number U05239.1 (1994). Finally, the Examiner has rejected Claims 1, 3-6 and 10 under 35 U.S.C. 102 (e) as allegedly being anticipated by Yu.

The Applicants respectfully disagree. As described above, the Applicants have amended Claim 1 and cancelled Claims 2-4 and 10. The amended claims are directed towards Orphanin FQ nucleic acid of SEQ ID NOs: 9, 10, 12, 14, 16, 18, 19, 20, and 21 (the limitation of Claim 2). As the Examiner has not rejected Claims 2 and 11-12 as allegedly lacking novelty, the Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicant encourages the Examiner to call the undersigned collect at (608) 218-6900.

Dated: February 27, 2004



Tanya A. Arenson
Registration No. 47,391
MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
(608) 218-6900